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10/578,996	05/11/2006	Carsten Herpel	PD030116	5098

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EXAMINER
VU, THANH T

ART UNIT	PAPER NUMBER
2175	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<table>
<tr><td rowspan="3">Office Action Summary</td><td>Application No.
10/578,996</td><td>Applicant(s)
HERPEL ET AL.</td><td></td></tr>
<tr><td>Examiner
THANH T. VU</td><td>Art Unit
2175</td><td></td></tr>
</table>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07 July 2009</u>.
2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-16</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-16</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

This communication is responsive to Amendment, filed 7/72009.

Claims 1-16 are pending in this application. In the Amendment, claims 11-16 were

added, and claims 1 were amended. This action is made Final.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

Claims 11, 14, 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite

for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention.

Claim 11 recites the limitation "the stored second portion of audio-visual data". There is

insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the exchangeable storage medium" and "said medium".

There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitation "selectable buttons another". It is unclear what is meant by

"selectable buttons another,"

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
> sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Dinallo et al.

(US 5,929,857).

Per claim 1, Dinallo teaches a method for automatically composing an electronic audio-

visual menu for selection of playback of audio-visual data, wherein a first portion of audio-visual

data and a first portion of menu data is retrieved from a first storage medium being an

exchangeable pre-recorded medium, and wherein a second portion of audio-visual data and a

second portion of menu data are obtained from a second data source different from said first

storage medium (fig. 1), wherein said second portion of menu data has at least one attribute

associated, the method comprising the steps of:

generating an initial menu from the first portion of menu data, the initial menu containing

one or more visible, selectable buttons and at least one invisible placeholder that cannot be

selected, wherein the placeholder has at least one attribute associated (col. 9, lines 1-12 and 35-

42, col. 10, lines 30-42);

extracting said attribute associated with the second portion of menu data (col. 7, lines 22-

25 and lines 53-58; col. 9, lines 1-12);

comparing said extracted attribute with said attribute associated with the placeholder; and

based on said comparison, if both attributes match, replacing the placeholder with a visible and

selectable button defined by the second portion of menu data (col. 7, lines 40-45 and lines 54-60;

col. 9, lines 44-51; col. 10, lines 31-42).

Per claim 2, Dinallo teaches method according to claim 1, further comprising the step of

automatically detecting the availability of said second portion of menu data or of said second

portion of audio-visual data (col. 7, lines 20-37; col. 10, lines 30-42).

Claim 3 is rejected under the same rationale as claim 1.

Per claim 4, Dinallo teaches method or device according to claim 1, wherein the second

data source is a local storage medium, and the data that defines the visible and selectable menu

button replacing the placeholder contains a unique reference to the stored second portion of

audio-visual data (fig. 1; storage medium 200 and 210).

Per claim 5, Dinallo teaches method or device according to claim 1, wherein the data that

defines the visible and selectable button replacing the placeholder further contains button

location information or a specification of conditions for button activation (col. 8, lines 18-41).

Per claim 6, Dinallo teaches method or device according to claim 1, wherein the data that

defines the visible and selectable button replacing the placeholder further contains picture data

defining the appearance of the button (col. 9, lines 40-51; col. 10, lines 30-42).

Per claim 7, Dinallo teaches method or device according to claim 1, wherein the

exchangeable storage medium is rewritable, and said second portion of audio-visual data and

said second portion of menu data are also stored on said medium (fig. 1; storage medium 200 and

210).

Per claim 8, Dinallo teaches method or device according to claim 1, wherein upon

replacement of one or more placeholders by one or more visible and selectable buttons another,

previously visible and selectable button defined in the first portion of menu data is disabled and

switched invisible (col. 8, lines 29-31, lines 55-56; col. 9, lines 1-12 and lines 44-51).

Per claim 9, Dinallo teaches method or device according to claim 1, wherein said second

portion of menu data contains navigation chaining information (col. 9, lines 44-52).

Claim 10 is rejected under the same rationale as claim 1.

Per claim 11, Dinallo teaches device according to claim 3, wherein the second data

source is a local storage medium, and the data that defines the visible and selectable

menu button replacing the placeholder contains a unique reference to the stored second portion

of audio-visual data (*fig. 2 shows a second data source 210; fig. 5 and col. 60-67; which states of*

menu buttons).

Per claim 12, Dinallo teaches device according to claim 3, wherein the data that defines

the visible and selectable button replacing the placeholder further contains button location

information or a specification of conditions for button activation (*fig. 5 and col. 60-67; which*

states of menu buttons).

Per claim 13, Dinallo teaches device according to claim 3, wherein the data that defines

the visible and selectable button replacing the placeholder further contains picture data defining

the appearance of the button (fig. 5 and col. 9, lines 1-12 and 60-67 and col. 10, lines 30-35;

which shows states of menu buttons having set of bitmaps).

Per claim 14, Dinallo teaches Device according to claim 3, wherein the exchangeable

storage medium is rewritable, and said second portion of audio-visual data and said second

portion of menu data are also stored on said medium (fig. 1 shows exchangeable storage medium

142, 147 and 152; fig. 2 shows audio visual data menu are stored on medium 210).

Per claim 15, Dinallo teaches device according to claim 3, wherein upon replacement of

one or more placeholders by one or more visible and selectable buttons another, previously

visible and selectable button defined in the first portion of menu data is disabled and switched

invisible (col. 8, lines 29-31 and lines 50-54, *which shows states of buttons and scroll off screen of menu*).

Per claim 16, Dinallo teaches device according to claim 3, wherein said second portion of menu data contains navigation chaining information (col. 10, lines 44-52).

Response to Arguments

Applicants' arguments in the Amendment have been fully considered but are not persuasive.

Applicant's primary argument is that Dinallo does not teach the limitations of " wherein a second portion of audio-visual data and a second portion of menu data are obtained from a second data source different from said first storage medium", and "comparing said extracted attribute with said attribute associated with the placeholder; and based on said comparison, if both attributes match, replacing the placeholder with a visible and selectable button defined by the second portion of menu data".

The examiner does not agree for the following reasons:

During patent examination, the pending claims must be "given >their< broadest reasonable interpretation consistent with the specification." > In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be

interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541,

550-51 (CCPA 1969).

In this case, Dinallo reads on the claimed language of "a second portion of audio-visual

data and a second portion of menu data are obtained from a second data source different from

said first storage medium". In fig. 2, Dinallo discloses an interface object database 210 (i.e

second data source) that is different from DVD disk 200 (i.e. a first storage medium). The

interface object database contains controls' attributes such as bitmaps, selected, active,

deselected and locations, see col. 7, lines 42-47 and col. 9, lines 54-67). Furthermore Dinallo

reads on the claimed language of "comparing said extracted attribute with said attribute

associated with the placeholder and based on said comparison, if both attributes match, replacing

the placeholder with a visible and selectable button defined by the second portion of menu data."

In fig. 5-6, col. 9, lines 60-67 and col. 10, lines 30-34, Dinallo discloses database query are used

to retrieve menu data containing attributes such as positions, color to indicate selected, active and

deselected states. The database query requires comparison of menu data attributes in order to

display states of buttons. In addition, fig. 7 of Dinallo is shown with a visible and selectable

buttons 730, 732 and 734 in the header 728.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to THANH T. VU whose telephone number is (571)272-4073. The

examiner can normally be reached on Mon- Fri 7:00 AM - 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, William L. Bashore can be reached on (571) 272-4088. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thanh T. Vu/
Primary Examiner, Art Unit 2175